

Attorney's Docket: 2002DE123  
Serial No.: 10/523,536  
Art Unit 1795  
Response to Office Action Mailed 9/15/2008

### REMARKS

The Office Action mailed September 15, 2008 has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

Applicant has amended the claims to. Claims 1 and 12 were amended to incorporate the elements of claims 6 and 8. Claim 17 was amended to properly depend from claim 1. Support for these amendments may be found in originally filed claims 1, 6, 8, 12, and 17. It is believed that no new matter has been introduced by these amendments.

Claims 1, 2, 5, 9, 10, 15, 16, and 22 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 3-8, 11, 12, and 14 of copending Application No. 10/523502. The rejection of claim 1 as amended on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 3-8, 11, 12, and 14 of copending Application No. 10/523502 should be withdrawn for the reason that as amended, claim 1 includes the elements of claims 6 and 8 which were not subject the rejection. The rejection of claims 2, 5, 9, 10, 15, 16, and 22 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 3-8, 11, 12, and 14 of copending Application No. 10/523502 should be withdrawn for the reasons given in support of amended claim 1 from which they depend.

Claims 1, 5, 9-12, 15, 16, 18, and 22-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,288,581 to Ziolo in view of US Patent No. 6,204,335 to Michel et al. The rejection of claims 1, 5, 9-12, 15, 16, 18, and 22-24

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under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,288,581 to Ziolo in view of US Patent No. 6,204,335 to Michel et al. is now moot in view of Applicant's amendment to claim 1 which includes all of the limitations of claims 6 and 8.

The rejection of claim 3 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,288,581 to Ziolo in view of US Patent No. 6,204,335 to Michel et al. is now moot in view of Applicant's amendment to claim 1 from which claim 3 depends which now includes all of the limitations of claims 6 and 8.

Claims 6, 8, and 17 were rejected under 35 U.S.C. 103(a) ) as being unpatentable over US Patent 5,288,581 to Ziolo (The '581 Patent) in view of US Patent No. 6,204,335 to Michel (the '335 Patent) as applied to claim 1, and further in view of US Patent 5,502,118 to Macholdt et al.(The '118 Patent). Applicant amended claim 1 to include all of the elements of claims 6 and 8, and canceled claims 6 and 8. The rejection of claim 1 as amended under 35 U.S.C. 103(a) ) as being unpatentable over US Patent 5,288,581 to Ziolo (The '581 Patent) in view of US Patent No. 6,204,335 to Michel (the '335 Patent) as applied to claim 1, and further in view of US Patent 5,502,118 to Macholdt et al.(The '118 Patent) should be withdrawn for the reason that the examiner has failed to make a prima facie case of obviousness, and for the reason that no one skilled in the art would have any expectation for success to make the claimed combination when the '581 and the '335 are silent on Applicant's specific anions, and for the reason that the '118 Patent reacts the diol compound to form a polyester moiety and is silent on Applicant's specific double layered Mg/Al hydroxide salts containing organic anions A. The Examiner is correct in that the '581 Patent discloses a toner comprising a charge enhancing additive, which may be a layered double hydroxide, which is made from hydrotalcite comprising di- and trivalent metal cations and organic anions such as salicylate. The examiner is further correct in that the '581 Patent does not disclose the specific anions of the instant application. The '335 Patent discloses a process for controlling the charge of an electrophotographic toner by

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adding a control agent which comprises metal carboxylates and salicylic acid etc., but the '335 Patent is silent on the use of any layered double hydroxides. Furthermore, in the office action under item 6, the Examiner has admitted that '581 Patent and the '335 Patent fail to teach the use of Applicant's specific organic anions. The '118 can not provide the missing element because the '118 Patent discloses the use of dicarboxylic acids which have been reacted with diols to form polyester moieties, and is silent on Applicant's specific double layered Mg/Al hydroxide salts containing Applicant's specific organic anions A. The '118 Patent discloses a process for controlling the charge of an electrophotographic toner wherein the charge control agent is a polymer salt whose anionic component is a polyester (See col. 5, lines 5-7). The polyester of the '118 Patent, however, comprises the reaction product of the individual components: a) dicarboxylic acid, b) sulfo acid, c) a divalent alcohol = diol, d) optionally polyfunctional compound, and e) optionally a monocarboxylic acid. (See col. 5, lines 25-40). It is respectfully submitted that the salts of the instant invention as claimed do not comprise any polyester moiety. In the '118 Patent, the dicarboxylic acid mentioned by the Examiner is reacted with a diol to form a polyester and thus, there is no diol component present. The present claim language recites "one or more organic anions A selected from the group consisting of benzoic acid, naphthalenedisulfonic acid, naphthalenedicarboxylic acid, hydroxynaphthoic acid, octanedicarboxylic acid, decanedicarboxylic acid, dodecanedicarboxylic acid, tetradecanedicarboxylic acid, hexadecanedicarboxylic acid, octadecanedicarboxylic acid, naphthalenetetracarboxylic acid, sulfosuccinic acid (C<sub>6</sub>-C<sub>20</sub>)-alkyl monoester, sulfosuccinic acid (C<sub>6</sub>-C<sub>22</sub>)-fluoroalkyl monoester, and an anion of a C<sub>12</sub>-C<sub>44</sub> fatty acid." This is clearly distinguishes from "polyester salts comprising the reaction products of such anions with diols etc" because when the polyester is formed, there is no longer an organic anion as recited in Applicant's amended claim. It is further respectfully submitted that a polyester has substantially different properties than a dicarboxylic acid. Clearly, no one skilled in the

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art armed with either the '118 Patent or either of the '581 or 335 Patents would have any teaching or suggestion to arrive at Applicant's invention without the use of improper hindsight. Applicant's amended claim 1 is directed to a process for controlling the charge of an electrophotographic toner which has a structure which is different from a polyester, and no one skilled in the art charged with solving the problem of controlling the charge of an electrophotographic toner would find any teaching or suggestion in any combination of the '581, the '335, or the '118 Patents to arrive at Applicant's process. Therefore, the rejection of claim 1 as amended under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,288,581 to Ziolo (The '581 Patent) in view of US Patent No. 6,204,335 to Michel (the '335 Patent) as applied to claim 1, and further in view of US Patent 5,502,118 (the '118 Patent) to Macholdt et al. should be withdrawn for the reason that the examiner has failed to make a prima facie case of obviousness, and for the reason that no one skilled in the art would have any expectation for success to make the claimed combination when the '581 and the '335 are silent on Applicant's specific anions, and for the reason that the '118 Patent reacts the diol compound to form a polyester moiety and is silent on Applicant's specific double layered Mg/Al hydroxide salts containing organic anions A.

The rejection of claim 17 under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,288,581 to Ziolo (The '581 Patent) in view of US Patent No. 6,204,335 to Michel (the '335 Patent) as applied to claim 1, and further in view of US Patent 5,502,118 (the '118 Patent) to Macholdt et al. should be withdrawn for the reasons given in support of claim 1 from which claim 17 depends.

Accordingly, favorable reconsideration and an allowance of all pending claims are courteously solicited.

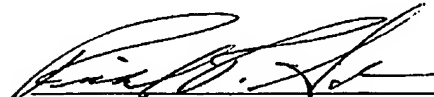
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An early and favorable action is courteously solicited.

Respectfully submitted,



Richard P. Silverman  
Registration No. 36,277  
Agent for Applicants

(CUSTOMER NUMBER 25,255)

CLARIANT CORPORATION

INDUSTRIAL PROPERTY DEPARTMENT

4000 Monroe Road, Charlotte, NC 28205

Telephone: (704) 331-7156

Facsimile: (704) 331-7707